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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,278	04/18/2006	Haruhiko Habuta	2006_0569A	9094
52349 7590 12/29/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
VERDERAME, ANNA L.				
ART UNIT		PAPER NUMBER		
1795				
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12/29/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,278

**Applicant(s)**

HABUTA ET AL.

**Examiner**

ANNA L. VERDERAME

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-29, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25, 27, 29, and 31 is/are rejected.
- 7) ☒ Claim(s) 26 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's amendment filed on 10/23/2009 has been carefully considered. A response is presented below.

#### ***Claim Objections***

1. Claims 26 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 25, 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Uno et al. WO 2004/027770(US 2005/0253210 used as an English language translation).

See medium number 2 in tables 1 and 2. Medium number 2 is a four layer optical recording medium having recording layers containing Te, O, and Pd. In medium number 2 the first recording layer/the layer nearest the light incidence plane has a compositional ratio of Pd which is 1% greater than that found in the second recording layer (see table 2). In this example the first recording layer corresponds to applicant's nth recording layer because it is the layer nearest the light incidence plane.

Disclosure is found on pages 20-25 of the WO document and in sections 0071-0076 of the US document.

With regard to claim 27 thicknesses of the recording layers in medium 2 are taught in table 1.

With regard to the limitation of claim 28, the examiner notes that both applicant and Uno et al. form the protective layers of 80:20 ZnS-SiO<sub>2</sub>. Therefore, the protective layers in Uno et al. inherently exhibit a refractive index of at least 1.5.

With regard to the limitation of claim 29 it is the position of the examiner that the Al-Cr reflective layer used in media number 2 taught by Uno et al. will inherently possess a refractive index of no more than 2 and an extinction coefficient of at least 2 based on the disclosure to use similar materials for the reflective layer on page 10 of the applicant's specification.

With regard to the limitation recited in claim 25 which requires that the compositional ratio of M in the layer nearest the light incidence plane be at least 2% greater than that in the next closest layer to the light incidence plane, the examiner notes that it has been held that prior art which teaches a range overlapping or touching the claimed range anticipates the claimed range (emphasis added). Medium number 2 of Uno et al. discloses varying the metal content in the layer nearest the light incidence plane so that the layer contains 1% more metal than the next closest layer to the light incidence plane. 1% touches the claimed range of at least 2%.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uno et al. WO 2004/027770(US 2005/0253210 used as an English language translation) in view of Kitaura et al. US 2002/0022105 and Yasuda et al. US 6,221,455.

Uno et al. discloses a four layer optical recording layer having recording layers which contain Te, O, Pd wherein the metal concentration in the recording layer nearest the light incidence plane is 1% greater than that in the next closest layer to the light incidence plane. Uno et al. does not disclose the limitations of claim 31.

Kitaura et al. 2002/0022105 teaches a single layer optical recording media in figures 1-2 comprising a Te,O,M recording layer 3 and a dielectric layer 2. The dielectric layer can be placed on either side of the recording layer 3(0037). Figure 3 teaches a dual-layer optical recording layer comprising a first information layer 7, a separation layer 8, a second information layer 9 and a protective layer 4. Here at least the first information layer 7 or the second information layer 9 comprises a dielectric layer 2 and a recording layer 3(0038). Media having 2 to six layers can be formed(0027). A four layer medium is shown in figure 7(emphasis added).

The dielectric layer 2 is made of a material having a refractive index not less than 1.5. Examples of materials for the protective layer include ZnS,  $\text{TiO}_2$ ,  $\text{ZrO}_2$ , Si, SiC,  $\text{Si}_3\text{N}_4$ , GeN or the like as the main component is suitable. Depending on the wavelength and the optical constant of each layer, it is preferable to determine the thickness to be in the range between  $0.31\lambda/n$  and  $0.5\lambda/n$  where  $\lambda$  is a wavelength of an optical beam used for recording and reproduction and  $n$  is a refractive index of the dielectric layer 2 is n(0040).

The wavelength used for recording is not more than 500 nm(0028).  $n$  is preferably 2.5 or more(0040). If a wavelength of 400 nm is used for recording and the refractive index of the protective layer is 2.5 then the minimum thickness for the recording layer  $0.31\lambda/n$  is 48 nm and within the range taught in claim 6.

As the material for the recording layer a material containing Te, O, and M wherein M is one or more elements selected from Al, Si, Ti, V, Cr, Mn, Fe, Co, Ni, Cu, Zn, Ga, Ge, Zr, Nb, Mo, Ru, Rh, Pd, Ag, In, Sn, Sb, Hf, Ta, W, Re, Os, Ir, Pt, Au, and Bi can be used. It is preferable that M is Pd or Au since a sufficient crystallization speed and high environmental stability can be obtained(0041). A preferable composition range for the recording layer 3 is from 25 to 60 atomic percent for O-atoms and from 1 to 35 atomic percent M-atom(0042). The recording layer has a thickness in the range of 5 nm to 70 nm(0029).

The reference discusses the results caused by adjusting the O-atom concentration and the M-atom concentration respectively (0043-0044). In an area where the O-atom in the recording layer is contained in an amount of 25 atomic percent

or less a thermal conductivity of the layer is too high so that recording marks become too large. Thus even if the recording power is enhanced the C/N ratio does not rise. On the other hand in an area where the O-atom concentration in the recording layer exceeds 60 atomic percent, a thermal conductivity of the recording layer becomes too low so that recording marks cannot be formed large enough even by enhancing the recording power. Thus the C/N ratio is low and the sensitivity also is insufficient(0043). In an area where M-atom in the recording layer 3 is contained at less than 1 atomic percent the function of promoting crystal growth is low and the crystallization speed in the recording layer is insufficient so that marks can not be formed at a high recording speed. On the other hand in an area where the M-atom concentration exceeds 35 atomic percent a reflectance change between the amorphous and the crystalline phase deteriorates so that the C/N ratio is low(0044).

In regard to the limitation of instant claim 31 which requires annealing of the recording layer at a temperature of 60°C or higher for at least five minutes after the recording layer had been formed, this limitation is taught in Kitaura et al at (0013).

It would have been obvious to anneal the recording layers in medium number 2 taught by Uno et al. by heating the recording layers at a temperature of 60°C or higher for at least 5 minutes after the recording layers have been formed based on the example of Kitaura et al. and with a reasonable expectation of success based on the similarities between the media taught by Uno et al. and Kitaura et al.

***Response to Arguments***

**7. Rejections Under 35 U.S.C. 112 second paragraph:** These rejections have been withdrawn due to applicant's amendment of the claims.

**8. Rejections under 35 U.S.C. 102(b):** Applicant's main argument regarding the Uno reference is that the 1% difference in metal contact taught in an embodiment does not touch the claimed range of at least 2% or  $\geq 2\%$ . This is incorrect. 1% does touch the range of at least 2%/2% or more. The Uno reference disclosure has the requisite specificity discussed at MPEP 2131.03 because 1% difference in metal content is found in an embodiment. The applicant seems to suggest that the difference in the metal content in the embodiment of the Uno et al. reference was not intentional. There is no basis provided for this position and inventive embodiments of a reference are rarely if ever accidental or unintentional.

**9. Rejection under 35 U.S.C. 103(a):** The rejection of claim 31 has been maintained. However, applicant's arguments regarding claims 26 and new claim 32 are persuasive. While the Uno et al. reference discloses a medium where the amount of M in a layer further from the light incidence plane is at least 1% greater than that in an adjacent layer nearer the light incidence plane and discloses that the metal content can be varied from 1-35%, the reference does not disclose changing the metal content in the layer further from the light incident plane to be 4 atom % or 5 atom % greater respectively than that in a layer nearer the light incident plane.



***Conclusion***

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA L. VERDERAME whose telephone number is (571)272-6420. The examiner can normally be reached on M-F 8A-4:30P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached at (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anna L Verderame/  
Examiner, Art Unit 1795

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1795